

REMARKS

Claims 1-14 have been examined. With this amendment, Applicant cancels claims 6 and 10-12 and adds claims 15-23. Claims 1-5, 7-9 and 13-23 are all the claims pending in the application.

I. Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1-3 and 5-14 under 35 U.S.C. § 102(e) as being anticipated by Safai *et al.* (US 6,167,469) ["Safai"]. For at least the following reasons, Applicant traverses the rejection.

A. Claim 1:

Applicant submits that Safai does not disclose or suggest a digital camera that comprises "a selection means selecting between the first memory section and the second memory section for selectively storing the image data" as set forth in claim 1.

The Examiner contends that that there must inherently be a selection circuit in the invention in Safai in order to "select between the storage device 212 and storage 614 so as to distribute the image data." Office Action at page 6 (in the rejection of claims 11 and 12).

To establish inherency, the extrinsic evidence must make clear the missing material is necessarily present in the reference. "Inherency, however, may not be established by probabilities or possibilities." MPEP 2100-54.

Applicant submits that, at most, Safai discloses that image data from camera 100 may be uploaded to storage 614 (col. 15, lines 34-36). Accordingly, it is possible and probable that

image data is also stored in storage device 212 (the alleged first memory). Therefore, Safai does not disclose or suggest “selectively storing” between the storage device 212 and storage 614.

Since the claimed selective storage as set forth in claims 1 and 5 does not necessarily have to be present in order to store the image data of Safai in storage 614, the Examiner’s contention that this feature is inherent is not supported by the prior art.

B. Claim 5:

Because independent claim 5 recites a feature similar to that given above with respect to claim 1, Applicant submits that claim 5 is patentable for at least reasons similar to those given above with respect to claim 1.

C. Claims 2, 3, 7-9, 13 and 14:

Applicant submits that claims 2, 3, 7-9, 13 and 14 are patentable at least by virtue of their respective dependencies.

II. Claim Rejections - 35 U.S.C. § 103(a)

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Safai in view of Fukuoka (US 5,754,227) [“Fukuoka”]. For at least the following reasons, Applicant traverses the rejection.

Applicant submits that the Examiner did not address Applicant’s arguments filed on March 8, 2004, with respect to claim 4. Merely pointing out the Examiner’s previous contentions does not constitute a substantive rebuttal since Applicant has already addressed these contentions. Accordingly, Applicant incorporates the arguments with respect to claim 4 filed in the March 8 response in their entirety.

III. New Claims

With this amendment, Applicant adds claims 15-23. Applicant submits that independent claims 15 and 19 are patentable for reasons analogous to those given above with respect to claim

1. Applicant submits that claims 16-18 and 20-23 are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Bhaskar Kakarla
Registration No. 54,627

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